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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/696,986	03/03/1997	PAUL DEFOURNY	DBS38	9267

7590 09/10/2003

BROWNING & BUSHMAN  
5718 WESTHEIMER SUITE 1800  
HOUSTON, TX 77057

EXAMINER
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LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/696,986

Applicant(s)

DEFOURNY ET AL.

Examiner

Jong-Suk (James) Lee

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 93-115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 113-115 is/are allowed.
- 6) ☒ Claim(s) 93-101, 107 and 109-112 is/are rejected.
- 7) ☒ Claim(s) 102-106 and 108 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 3673**.

2. The request filed on June 8, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/696,986 is acceptable and a CPA has been established. An action on the CPA follows.

3. The preliminary amendment filed on August 12, 1999 has been entered.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

16 A person shall be entitled to a patent unless --

17 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or  
18 on sale in this country, more than one year prior to the date of application for patent in the United States.

20 5. Claims 93, 96-100 and 109-111 are rejected under 35 U.S.C. 102(b) as being anticipated  
21 by Black (US 3,135,103).

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1           Black discloses a flexible joint for drill string comprises a transfer member (27) for  
2 transmitting weight and torque between first and second members (19, 20) through a resilient  
3 deformable member/spacer (23). The transfer member extending between the first member and  
4 second member and the second member permitting the first member to tile with respect to the  
5 second member, and the transfer member includes a series of radial teeth on the first member (19)  
6 and recesses in the second member (20) at the portion wherein the transfer member secured at the  
7 socket portion (22) of the drill string (see Fig. 2) and a threaded locking ring/plug (27)  
8 surrounding the first member and engaging threads on the second member. The second member  
9 (20) formed with a connecting means (26, 28) (see Figs. 1-4; col.1, lines 53-72; col.2, lines 1-  
10 46)..

11  
12       6.       Claims 93, 94, 100, 107 and 112 are rejected under 35 U.S.C. 102(b) as being anticipated  
13 by Bodine (US 4,261,425).

14           Bodine discloses a drill bit coupled to an orbiting mass oscillator comprises a first  
15 member/shank (11), a second member/drill bit body (16) and resiliently deformable connecting  
16 member (22) between the first and second members, rolling cutters (14) movably mounted on the  
17 drill bit body (see Figs. 1-5; col.2, lines 7-29).

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1 7. Claims 93 and 95 are rejected under 35 U.S.C. 102(b) as being anticipated by Ortloff (US  
2 2,740,651).

3 Ortloff discloses a resiliently coupled drill bit comprising of: a first member/drill bit body  
4 (11, 13) for attachment to the drill string; a second member comprising a drilling member/drill  
5 cutter (19, 21), and a resiliently deformable spacer (23) intermediate the first and second member  
6 for transmitting torque and weight therebetween (see Figs. 1-4; col.2, lines 26-72; col.3, lines 1-  
7 48).

8  
9 ***Claim Rejections - 35 USC § 103***

10 8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness  
11 rejections set forth in this Office action:

12 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
13 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
14 such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
15 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
16 manner in which the invention was made.  
17

18 9. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodine.

19 Although Bodine et al. fails to disclose the connecting member having a hydrogenated  
20 nitrile rubber having a Shore A hardness of at least 80, it is well known expedient within the  
21 drilling art to utilize the elastomeric material such as the elastomer having a Shore A hardness of  
22 at least 80 for resiliently connecting member/ the elastomeric seal in order to reduce extrusion

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1 under load. Further, such modification would have constituted an alternative means/ obvious  
2 matter of design choice well within the ordinary skill in the art.  
3

4 *Allowable Subject Matter*

5 10. Claims 113-115 would be allowable over the prior art of record.

6 11. Claims 102-106 and 108 are objected to as being dependent upon a rejected base claim,  
7 but would be allowable if rewritten in independent form including all of the limitations of the base  
8 claim and any intervening claims.  
9

10 *Conclusion*

11 12. The prior art made of record and not relied upon is considered pertinent to applicant's  
12 disclosure. Other reference cited disclose ..

13 13. Any inquiry concerning this communication or earlier communications from the examiner  
14 should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The  
15 examiner can normally be reached between the hours of 6:30 AM to 3:00 PM Monday thru  
16 Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,  
17 Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for this  
18 Group is (703) 305-3597.

19 Any inquiry of a general nature or relating to the status of this application or proceeding

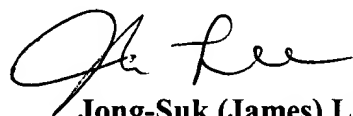
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1 should be directed to the Group receptionist whose telephone number is (703) 308-2168.

2  
3 J. Lee /jjl  
4 September 4, 2003  
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Jong-Suk (James) Lee  
Primary Examiner  
Art Unit 3673